

AIPLA

AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

2001 JEFFERSON DAVIS HIGHWAY ■ SUITE 203 ■ ARLINGTON, Virginia 22202

May 3, 2006

The Honorable Jon Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office
Mail Stop Comments
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Catherine M. Kirik
Office of the Commissioner for Patents

Comments on Proposed Rule: "Changes to Eliminate
the Disclosure Document Program"
71 Fed. Reg. 17399 (April 6, 2006)

Dear Under Secretary Dudas:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the proposal by the U.S. Patent and Trademark Office ("PTO") to eliminate the Disclosure Document Program published at 71 Fed. Reg. 17399 (April 6, 2006).

AIPLA is a national bar association whose 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both patent owners and users of intellectual property.

The PTO is again proposing to abolish the Document Disclosure Program, introduced in 1969. The PTO received a number of comments supporting the elimination of the Document Disclosure Program in response to a Notice published in 1998, but did not receive any input from the independent inventor community and decided to delay eliminating the program.

A disclosure document may include a written description of an invention to establish a date of conception of an invention at least as of the date filed in the PTO. A modest \$10 filing fee is required. A disclosure document is destroyed two years after filing unless it is referenced in a later provisional or nonprovisional application. We understand that it is rare that such a reference is made, and are not aware of any reported case where such a document was of any value to an inventor.

In its justification for again proposing the elimination of the Document Disclosure Program, the PTO indicates that "independent inventors have become more familiar with and are using provisional applications more often than they were in 1998, and provisional applications provide more protection for independent inventors than disclosure documents."

While we agree with this observation, it does not explain the continuing growth, over the past ten years, in the number of disclosure documents filed annually in the range of about 20-30,000. Given the limited content of most document disclosures, it is probably in the best interest of inventors that they spend only \$10 per filing rather than \$100 in filing a provisional application.

The PTO correctly points out that inventors have alternatives to establish a date of conception of their inventions, and do not need the Document Disclosure Program. There also is some evidence that some so-called invention developers have been misleading small inventors as to the value of the Document Disclosure Program. While we struggle to find any value in the continuation of the Document Disclosure Program, the independent inventor community should be consulted and is in a better position to determine whether there is value in the continuation of this program.

We appreciate the opportunity to provide comments on the proposed rule change and are available to assist the PTO in further developing patent practice and procedures.

Sincerely,

A handwritten signature in black ink that reads "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk
Executive Director